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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 10/661,912 | 09/12/2003 | James P. Gardner JR. | 163.1324US11 (ECO0021/US/ | 8343 |
| 70959 | 7590 | 07/05/2007 | EXAMINER | |
| KAGAN BINDER, PLLC SUITE 200, MAPLE ISLAND BUILDING 221 MAIN STREET NORTH STILLWATER, MN 55082 | | | LEVY, NEIL S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1615 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 07/05/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|--------------------------------|--|
| Office Action Summary | Application No. 10/661,912 | Applicant(s) GARDNER ET AL. | |
| | Examiner NEIL LEVY | Art Unit 1615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 31-40, 45 and 47-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31, 41-44, 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 31-40, 45 and 47-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/30/06, 11/13/03</u> | 6) <input type="checkbox"/> Other: _____ |

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Election/Restrictions

Applicant's election with traverse of Group I, species boric acid, protein, and Mg in the reply filed on 3/08/07 is acknowledged. The traversal is on the ground(s) that There is insufficient basis for restriction. This is not found persuasive because See SCHULER 2957804 column 7, line 9; column 8, line 6. Example 1 for food based rat baits-

acephate was examined as the elected insecticide, per telephone discussion with attorney, Dennis Daley on 5/18/07.

The requirement is still deemed proper and is therefore made FINAL.

Claim 31-40, 45, 47-52 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/8/07.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-5, 7-14, 16, 17, 20, 21, 41, 42 and 46 are rejected under 35

U.S.C. 102(b) as being anticipated by BARCAY et al 5820855. See food base baits at column 3, Example 1, 2 water sensitive insecticide, boric acid and water and attractant stimulant. Absent specifying claimed functional elements, boric acid is seen as stabilizer insecticide. Efficacy is as of the instant-increased speed of kill (column 1, line 64; column 2, line 5 and column 4, lines 37-41).

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Alternatively, BHT is considered a stabilizer (column 4, top) and acephate is the insecticide, or carbamates or pyrethroids (column 2, lines 43-55).

Claim 1-5, 7, 9, 10, 12, 13, 15-20 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated HONSYU et al CN1155978.

Stabilizer can be emulsifier (claim 1), or antioxidant (claim 2) or preservative (claim 7). Mixing is at claim 9. Acephate is at claim 3, attractant at claim 4. The high toxicity (page 3) is provided by the formulation, that of the instant as claimed, so, inherently, of the same claimed results-100% death resulted after 72 hours (Table 3) for cockroach.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-21, 24-29, 41, 42, 46 are rejected under 35 U.S.C. 102(b) as anticipated

by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DYKSTRA et al

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See claim 2-baits include feeding stimulants and attractants (page 5) and humectants to retain water (50% in Example, page 6) included are protein, oil, and molasses (page 5). Mortality was more than 50% in 1 day, and 95% at 72 hours, thus meeting the instant claims, if cockroach is the insect. Boric acid (Example 1) is 5% acephate is used at 0.5% (Example 3) thus obvious to combine at these rates, when combination (page 5, lines 8, 9, claim 2) are used.

Claim. 1-21, 24-29, 41, 42 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over BARCAY et al 5828551 or HONGYU-CN or DYKSTRA-WO in view of KATAYANA et al 633026 and further in view of BLUM 5518719.

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Double Patenting

Claim 1-21, 25-29, 41 and 42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-11 of U.S. Patent No. *7192600. Although the conflicting claims are not identical, they are not patentably distinct from each other because Patent claims anticipate the instant claims 1, 3, 4, 6-8, 15-21, 25-29, 41, 42. Claims 2, 5, 9-14 inherently follow, as the composition is that of the instant.

Claim 1-6, 8, 9, 11, 14, 16, 21, 41, 42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-16 of U.S. Patent No. 5820855. Although the conflicting claims are not identical, they are not patentably distinct from each other because The patent anticipates the instant claims, if boric acid is considered both water sensitive effectively insecticidal and stabilizing.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

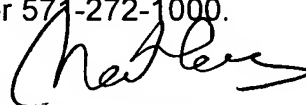
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL LEVY whose telephone number is 571-272-0619. The examiner can normally be reached on Tuesday-Friday, 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



NEIL LEVY
Primary Examiner
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